

In re Patent Application of:
MARTIN HERING
Serial No. 09/705,152
Filing Date: 11/2/2000

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Remarks

Applicant and the undersigned would like to thank the Examiner for his efforts in the examination of this application. Claims 62, 64-66, and 86-93 remain in the case. Reconsideration is respectfully requested. Claims 87 and 91-93 were rejected under 35 USC §112, second paragraph. Claims 62, 64-66, and 86-93 were rejected under 35 USC §103(a) as being unpatentable over US Patent No. 2,068,323 to Harrison et al. in view of US Patent No. 3,839,825 to Nica.

Applicant appreciates the Examiner's determination that there is no single reference that anticipates the present invention. Respectfully, the Examiner's rejection under 35 USC §103 fails to make a *prima facie* case of obviousness because there is no suggestion for combining the two references. In addition, a combination, as suggested by the Examiner, would defeat the objective of both the primary reference of Harrison '323 and that of Nica '825.

Nica'825 teaches a turnstile rotor construction in which the rotor arms are mounted in a manner to eliminate the presence of protuberant mounting structures and devices on the exterior surface of the mounting post (see Col 2, Lines 14-18). To enhance the appearance of the rotor arms, a sheath or sleeve extends the full length of the arm for providing an aesthetic enhancement (see Col 6, Lines 28-32). Such a teaching is consistent with "aesthetics" and with avoiding "protuberances," both of which are a teaching away from the advertising method of the claimed invention. Nica'825 teaches covering the entire arm with stainless steel (see Col 6, Line 32), stainless steel providing an opaque covering, including end portions of each arm, as illustrated by way of example with reference to FIG. 1. There is no suggestion to use the stainless steel in an advertising manner as taught by the Applicant, and called for in the claimed invention.

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As indicated by the Examiner, Harrison '323 is silent regarding the turnstile arm having a generally circular outside surface in cross section and having the sleeve encircling a substantial portion of the arm. Applicant would suggest that Harrison '323 is not only silent but teaches away from a sleeve encircling a substantial portion of the arm outside surface, as defined by the generally circular cross section. In fact, Harrison '323 teaches adapting the arms for display purposes (see Col 3, Lines 12-14 and FIGS. 3 and 5) to include a base portion (20), downwardly projecting sidewalls (21), a central reinforcing rib (22), and parallel lips (25) defining grooves (26) for receiving a glass display window (27). by way of example.

The Examiner has stated that it would have been obvious to one of ordinary skill in the art to provide Harrison et al with tubular arms and tubular sleeves, as taught by Nica, to improve the aesthetic appearance of the turnstile (Page 3, Par. 3). The Examiner further states (Page 4, Par. 2) that it is well known in the art to provide turnstiles with generally cylindrically shaped arms to give the turnstile an aesthetically appealing appearance and to reduce the amount of injuries/discomfort to people using the turnstile, and merely updating the old turnstile construction of Harrison et al. is well within the grasp of one skilled in the art. Respectfully, such motivation of the cited reference is not that of the claimed invention, and it is only through the teachings of the Applicant that one would be directed to combine the references herein described. Again, Harrison '323 teaches adapting a turnstile arm, and Nica '825 teaches a sheath for improving aesthetics and covering protuberances. The claimed invention neither modifies the arm nor is interested in aesthetics or covering protuberance. Factually, the sleeve of the claimed invention is indeed a protuberance. The invention is clearly directed to advertising carried on the surface of a turnstile arm. It would therefore appear to only be through hindsight that Harrison '323 and Nica '825 would be combined as suggested by the Examiner.

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Further, combining the teachings of the references would not lead to the claimed invention unless modifications to either reference were made according to the teachings of the Applicant. By way of example, the combination of Harrison '323 and Nica'825 (without hindsight) would produce a sheath covering arms having downwardly projecting sidewalls, a central reinforcing rib, and parallel lips defining grooves for receiving the sheath. by way of example. Case law including *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1992); *In re O'Farrell*, 853 F.2d 894, 903-904, 7 USPG2d 1673, 1681 (Fed. Cir. 1988); and *In re Dow Chem.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988) would suggest a *prima facie* obviousness for the claims in the case has not been established.

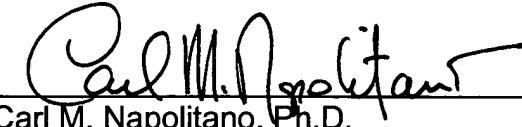
With regard to secondary conditions supporting nonobviousness, the evidence of commercial success must be considered persuasive in light of the prior art. The Examiner is asked to reconsider the commercial success supported by the Declarations of Martin Herring. The Examiner appears to have only focused on whether a long felt need was established, stating that the evidence of success was not persuasive (Page 4, Par. 3). Respectfully, long felt need is only one secondary consideration for nonobviousness, and is to be distinguished from commercial success, for which support is certainly provided by the Declarations of Martin Hering. The teachings of Harrison '323 have been available to those of ordinary skill in the art since 1935. As implied by the Examiner's combination of Harrison '323 and Nica '825, those of skill in the art should have been advertising from modern turnstile arm since 1974. With reference to the Hering Declarations, it was only through the inventiveness of the Applicant, about twenty years later, that such advertising was created.

Applicant respectfully submits that the above amendments place this application in a condition for allowance, and passage to issue is respectfully solicited. The Applicant and the undersigned would like to again thank the Examiner for his efforts in

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the examination of this application and for reconsideration of the claims as amended in light of the arguments presented. If the further prosecution of the application can be facilitated through telephone interview between the Examiner and the undersigned, the Examiner is requested to telephone the undersigned at the Examiner's convenience.

Respectfully submitted,


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CERTIFICATE OF MAILING

I hereby certify that the foregoing is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, this 20th day of December, 2004.


Suzanne Welch Yenser